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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,007	06/15/2001	Leo Kayser III	2110/12/99	9904
47441	7590	11/17/2006	EXAMINER	
WILLIAM LAWRENCE MUCKELROY PC 1901 NORTH OLDEN AVENUE, EXT SUITE 3A EWING PROFESSIONAL PARK TRENTON, NJ 08618			OYEBISI, OJO O	
			ART UNIT	PAPER NUMBER
			3692	

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/882,007

Applicant(s)

KAYSER, LEO

Examiner

OJO O. OYEBISI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In the amendment filed on 08/22/06, the following have occurred: claims 1-5 are pending in the application, claims 1-5 are represented in their original forms for examination; the objection to oath/declaration has been withdrawn, and applicant has filed 37 CFR 1.131 affidavit to overcome the rejection based on the prior art of record, Levine et al (US PAT: 6,233,566). Further, claims 1-5 stand rejected in this office action.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 4, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Levine et al (Levine hereinafter, US PAT: 6,233,566).

Re claims 1, 2. Levine discloses a computer system for conducting a savings and loan auction between a plurality of saver's institutions acting on behalf of a plurality of savers and a plurality of borrower's institutions acting on behalf of pre-qualified borrowers for a plurality of pre-set amounts of offered principal, each offered principal being offered for one of a plurality of pre-set time periods via a funds auctioneer (see abstract), said computer system comprising: (a) at

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least one computer maintained by said funds auctioneer (see fig.1 and 2); (b) at least one computer network connected to said computer (see fig.1 and 2); (c) means for receiving an electronic savings deposit offer and ask rate from a prospective saver's institution over said at least one computer network (see fig.24 under search for pools and browse all pools); (d) means for receiving an electronic loan request and bid rate from a prospective borrower's institution over said at least one computer network (see fig.24 under search for pools and browse all pools); (e) means, located at said funds auctioneer, for electronically sorting, matching, and selecting electronic savings deposit offers and ask rates which match with electronic loan requests and bid rates to form a plurality of matches of bids and asks or transactions (see abstract, also see fig.24 under search for pools and browse all pools); (f) means, operated by said funds auctioneer, for electronically confirming each said match of a bid and ask to each said saver's institution and each said borrower's institution which is a party to the matched bid and ask or transaction over said at least one computer network or another computer network (see fig.15 A element 1528 (accept, decline, and counter offer, also see fig.15 B and 15 D elements 1536 and 1580); (g) means, operated by said funds auctioneer, for electronically confirming each said match of a bid and ask to a clearinghouse and a surety (see fig.16 elements 1616 and 1620), specifying each said saver's institution and each said borrower's institution, which is a party to the matched bid and ask or transaction, over said at least one computer network or another computer network (see fig.16); (h) means, operated by said funds auctioneer, for electronically

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monitoring payments of principal and interest from each borrower's institution that is a party to a transaction via the clearinghouse bank to each saver's institution that is a party to the matched transaction (see fig.17, also see col.24 lines 65-67); (i) means for electronically issuing a negotiable certificate of deposit from the auctioneer to a saver via saver's institution and the clearinghouse bank (i.e., certificate of deposit see col.7, lines 40-46) ; (j) means for electronically redeeming and issuing notification of redemption of said auctioneer's negotiable certificate of deposit to the surety (i.e., trust company), the clearinghouse bank, the saver's institution, and the borrower's institution (i.e., when the trust company completes the review of the loan files, it notifies the buyer if the loans are certified.....see col.24, lines 37-56) ; (k) means, operated by said funds auctioneer, for electronically monitoring payments of principal and interest from each borrower's institution that is a party to a transaction via the clearinghouse to each saver's institution that is a party to the matched transaction (see col.24 lines 60-67); and, (l) means for electronically transferring final principal and accrued interest from the borrower's institution via the clearinghouse bank to the auctioneer's certificate holder and canceling the auctioneer's certificate of deposit (see fig.16 element 1624).

Re claim 4. Levine further discloses the computer system of claim 1 further comprising a local area network ("LAN") connected to said computer, said local area network including a plurality of computers (see fig.2A and B)

Re claim 5. Claim 5 recites similar limitations to claim 1, and thus rejected using the same art and rationale in the rejection of claim 1.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Levine in view of Fraser et al (Fraser hereinafter, US PAT: 5,995,947).

Re claim 3. Levine does not explicitly disclose the computer system of claim 2, further comprising means for electronically distributing a fee, the difference between the principal and discounted principal, to the auctioneer, the borrower's institution, the saver's institution, and the surety. However, Fraser makes this disclosure (i.e., the borrower and the lender are each charged a fee for the service provided by the transaction server. The fee is paid out of escrow funds by a selected escrow company when the loan and an associated purchase of the property are completed. The amount of the fee can be fixed or can be varied in response to the prospective loan information, such as the amount of the loan, and in a preferred embodiment is varied in response to CRA qualification for the loan, see col.14 lines 50-53). Thus, it would have been obvious to one of ordinary skill in the art to combine Levine and Fraser in order to make sure that the transaction facilitator gets paid for the service provided.

Response to Arguments

6. Applicant's arguments filed 08/22/06 have been fully considered but they are not persuasive. The applicant made these following arguments: "For purposes of applying Rule 131, the effective filing date of the Kayser application is the date of filing of the provisional, namely, June 20, 1999; since the specification of the provisional supports all of the claims of the application. Thus, the issue presented is what is the issue date or publication date of the Levine et al patent reference? Levine et al. issued on May 15, 2001. This is the effective date of this patent. Thus, the patent issued after the effective date of the application and is therefore not a bar under 35 U.S.C. 102(b). Levine et al. is not based on an international application filed prior to November 29, 2000 and is therefore not subject to the former (pre-AIPA) version of 35 USC 102 (e). Revised 35 USC 102(e) has two separate clauses as printed above: 35 USC 102(e)(1) is for publications and 35 USC 102 (e)(2) is for U.S. patents. Thus, 35 USC 102(e) (2) is the sole Clause applicable to this application." The examiner asserts that the applicant's argument is replete with errors. First, the effective filing date of Kayser application is Jun. 20, 2000 (i.e., the filing date of the provisional application 60/212,718, which Kayser claims priority from), not June 20, 1999 as claimed by the applicant supra. Second, the applicant misconstrued the May 15, 2001 issued date of Levin et al patent for the effective date of this patent. Contrary to this assertion, the effective date of Levine patent is Dec 31,

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1998 – this is the filling date of the provisional application 60114,578, which Levine et al claims priority from. Thus if this is true, the 35 U.S.C 102(e) rejection given by the examiner is proper, since 35 U.S.C 102 (e) clearly states: A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Lastly, the applicant states that the patent issued after the effective date of the application and is therefore not a bar under 35 U.S.C. 102(b). This statement is erroneous because the examiner rejection is based on 35 U.S.C 102(e), not 102(b) as claimed by the applicant.

Further, the declaration filed on 08/22/06 under 37 CFR § 1.131 has been considered but is ineffective to overcome the Levine et al reference.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the these references.

A general allegation that the invention was completed prior to the date of the reference is not sufficient. Ex parte Saunders, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

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37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred."). See MPEP 715.07 "Facts and Documentary Evidence". In the instant case, applicant fails to present any evidence/exhibits.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD E. CHILCOT can be reached on (571)272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



FRANTZY POINVIL
PRIMARY EXAMINER

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